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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,576	01/23/2004	Armin Faller	7863-80963	3025
42798	7590	09/28/2006	EXAMINER	
FITCH, EVEN, TABIN & FLANNERY P. O. BOX 18415 WASHINGTON, DC 20036			FIDEI, DAVID	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 09/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/762,576

Applicant(s)

FALLER, ARMIN

Examiner

David T. Fidei

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 23-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 5/19/04 & 1/23/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Claims 23-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on July 21, 2006.

2. Applicant's election with traverse of the invention in the reply filed on July 21, 2006 is acknowledged. The traversal is on the ground(s) that the rationale for "the restriction requirement seems at first blush to be disconnected with the language of the claims. The general suggestion to consider all claims together, MPEP 803, is apropos and rejoinder with examination of all claims is courteously solicited".

This is not found persuasive because the arguments only set forth conclusions. "For purposes of the initial requirement, a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP § 808.02. That prima facie showing may be rebutted by appropriate showings or evidence by the applicant.", see MPEP § 803. Applicant has not provided any showings but merely alleges there is no serious burden. Insofar as the criteria for restriction practice establishes, there is a prima facie showing provided by the initial holding.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. Examples in claim 1 of indefinite language is the term "its"; "the width", "the length" and "the flat-disposed first strip" are terms that lack antecedent basis. Finally, regarding claim 1, the word "means" is preceded by the word(s) "by" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function.¹ However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, 4, 6-8, 11-16 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Haile (US Patent no. 2,771,187). An envelope, or pouch, is disclosed in figures 3 and 4 substantially as identically claimed where strip-shaped connecting regions are formed at margins by heat sealing along edges 16, 17 and 18 whereby a second strip is connected under a formation of a pouch. A lid portion is formed by 15', 15.

As to claim 6-8, Haile states that a separate sheet is preferred for forming the second strip, however there is provided a disclosure of a single folded sheet in col. 2, lines 45-50 even

¹ We have held that use of the word "means" creates a presumption that §112, ¶ 6 applies. See *York Prods., Inc. v. Cent. Tractor*, 99 F.3d 1568, 1574 [40 USPQ2d 1619] (Fed. Cir. 1996).

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though this is not the favored construction. Also, plastic is considered a “coherent” material when heated in as much as is claimed.

As to claim 12, heating as in welding the plastic sheets together is considered to result in crimped locations in that pressure and melting results in a reduction of combined thickness at such locations as evidenced in the drawings of Haile.

7. Claims 1-3, 6-8, 10, 13 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Hankins (US Patent no. 969,141). An envelope, or pouch, is disclosed in figure 2 substantially as identically claimed where strip-shaped connecting regions are formed at margins by adhesive “h” along the side edges whereby a second strip is connected under a formation of a pouch. A lid portion is formed by “c”. The reference to a folded blank is taken to imply a paper material as would be understood by one skilled in the art.

8. Claims 1-3, 5-9, 13-16, 18 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by M^cGrane (US Patent no. 3,014,582). An envelope, or pouch, is disclosed in figures 1 and 2 substantially as identically claimed where a first strip-shaped region 4 and a second strip-shaped connecting portion that may be considered either of members 5 or 6 where the two folds lines connecting the side flaps 5, 6 constitute margins. Column 2, line 5 refers to a paper material with a glazed surface that is considered a laminate.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haile (US Patent no. 2,771,187) and Hankins (US Patent no. 969,141). The difference between the claimed subject matter and the prior art of Haile and Hankins resides in the material of strip. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a laminated material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice, see § M.P.E.P. 2144.06.

As to claim 9, forming the pouch from a single strip longitudinally folded is shown in the prior art of record as known to those skilled in the container art. To form the pouch in this manner would have been a matter of routine skill and obvious as a matter of design choice.

12. Claims 12, 17, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haile (US Patent no. 2,771,187), Hankins (US Patent no. 969,141) as applied to claim 1 above, and further in view of Minton et al (US Patent no. 5,462,166). Minton et al is cited for the teaching of an adhering tap 169 crimp sealing along edges 200. To form the pouch Haile (US Patent no. 2,771,187) with a an adhesive tab would have been obvious to one skilled in this art, for the reasons of providing a reusable means to secure the flap over the pouch.

13. Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claim 1 above, and further in view of Pavel et al (US Patent no. 4,765,473). It would have been obvious to one of ordinary skill in the art to provide a plastic box as taught by Pavel et al, in order to provide a device for storing a plurality of packages.

REPLY BY APPLICANT OR PATENT OWNER TO THIS OFFICE ACTION

14. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including: “The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. A general allegation that the claims “define a patentable invention” without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. Moreover, “The prompt development of a clear Issue requires that the replies of the applicant meet the objections to and rejections of the claims.” Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06 II(A), MPEP 2163.06 and MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.

If no amendments are made to claims as applicant or patent owner believes the claims are patentable without further modification, the reply must distinctly and specifically point out the supposed errors in the examiner’s action and must respond to every ground of objection and rejection in the prior Office Action in the same vain as given above, 37 CFR 1.111 (b) & (c), M.P.E.P. 714.02.


The examiner also points out, due to the change in practice as affecting final rejections, older decisions on questions of prematureness of final rejection or admission of subsequent amendments do not necessarily reflect present practice. “Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c)” (emphasis mine), see MPEP 706.07(a).

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Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fidei whose telephone number is (571) 272-4553. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


David T. Fidei
Primary Examiner
Art Unit 3728

dtf
September 4, 2006